

The opinion in support of the decision being entered today was not written for publication and is not precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DING-YU CHUNG and YUEHUA LIU

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Appeal No. 2003-0754  
Application No. 09/553,630

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Heard: August 20, 2003

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Before WALTZ, TIMM and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 10-16. Claims 1-9 have been cancelled.

Claim 16 is representative of the subject matter on appeal and is set forth below:

16. A substrate coated with a dried and cured layer of a clear aqueous cathodic electrocoating composition comprising a binder of an epoxy-amine adduct of an epoxy resin that has been reacted with an amine, a blocked polyisocyanate crosslinking agent, and an organic or inorganic acid as the neutralizing agent for the epoxy amine adduct; wherein the improvement is a catalyst of an alkyl tin oxide that has been dissolved with an organic or inorganic acid prior to incorporation in the coating composition.

The examiner relies upon the following references as evidence of unpatentability:

DeBroy et al. (DeBroy)	5,070,149	Dec. 3, 1991
Büttner et al. (Büttner)	5,176,804	Jan. 5, 1993
Zwack et al. (Zwack)	5,948,229	Sep. 7, 1999 (Filed Mar. 19, 1997)
Jamasbi	6,084,026	Jul. 4, 2000 (Filed Jun. 1, 1998)

Claims 10, 12, 13, and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Büttner.

Claims 10-16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Büttner in view of DeBroy, Zwack or Jamasbi.

Appellants filed an Appeal Brief on March 26, 2002. In response, the examiner reopened prosecution in the Office Action mailed May 20, 2002. In response, appellants filed a Supplemental Brief on October 15, 2002. In the Supplemental Brief, appellants requested that their statements made in the Brief filed on March 26, 2002 be considered in conjunction with the Supplemental Brief. We have carefully reviewed both the Appeal Brief and the Supplemental Brief. In this appeal, when we refer to the Brief, we are referring to the Supplemental Brief filed on October 15, 2002, while being aware that in the Supplemental Brief, appellants refer to their position made in Appeal Brief filed March 26, 2002.

On page 2 of the Brief, appellants state that the claims stand or fall together. We therefore consider claim 16 in this appeal. 37 CFR § 1.192(c)(7) and (8)(2000).

For the reasons set forth below, we reverse each of the rejections.

As a preliminary matter, we note that on pages 3-4 of the Brief, appellants argue that this appeal should be decided as a matter of law in favor of appellants. Appellants state that the present application is a divisional application with claims drawn only to a coated article. Appellants state that the clear aqueous cathodic electrocoating composition has already been deemed patentable by the Patent Office in U.S. Patent No. 6,123,866. Appellants argue that because the composition claims have been deemed patentable, the product made from the composition should be also deemed patentable (as a combination).

In response, the examiner states that he is not bound by the opinions of a different examiner regarding patentability of the composition claims. (Answer, page 5).

We note that patent disclosures are often very complicated and different examiners with different technical backgrounds and levels of understanding may often differ when interpreting such documents. In re Dayco v. Total Containment Inc., 329 F.3d 1358, 1365-66, 66 USPQ2d 1801, 1808 (Fed. Cir. 2003). As such, an examiner is not bound to follow another examiner's interpretation. Also, compare In re McDaniel, 293 F.3d 1379, 1383-84, 63 USPQ2d 1462, 1467-86 (CAFC 2002), wherein the Court stated that it is well settled that the prosecution of one patent application does not affect the prosecution of an unrelated application. See also In re Wertheim, 541 F.2d 257, 264, 191 USPQ 90, 97 (CCPA 1976). ("It is immaterial in ex parte prosecution whether the same or similar claims have been

allowed to others").

Therefore, we disagree with appellants' position in the present case that because the composition claims have been allowed in a separate application by a different examiner, involving the same art, the present claim should also be found allowable as a matter of law.

Hence, the critical issue before us in resolving each of the rejections is whether Büttner discloses use of a catalyst of an alkyl tin oxide that has been dissolved with an organic or inorganic acid prior to incorporation in the coating composition.

We note that when an examiner relies upon a theory of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex Parte Levy, 17 USPQ2d 1461, 1464 (BPAI 1990). Here, the examiner asserts "there is no doubt that the catalyst is soluble in the acid. If there is enough acid present in the composition, all the catalyst will be dissolved." Answer, page 4. However, the examiner does not support these statements by any basis in fact and/or technical reasoning. For example, the examiner does not explain how there is enough acid present in Büttner to dissolve the catalyst. The examiner states that he has invited appellants to show whether one mole of DBTO does or does not dissolve in five moles of acid but appellants fail to avail themselves to this opportunity. However, it is the examiner's burden of providing factual evidence and/or technical reasoning to support the determination of inherency. See In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); In re King, 801 F.2d 1324, 1327, 231 USPQ 131, 138-39 (Fed. Cir.

1986). Here, the examiner has not met this burden.

Because the examiner has not shown that the allegedly inherent characteristic (the alkyl tin oxide is dissolved with an organic or inorganic acid prior to incorporation in the coding composition) necessarily flows from the teachings of Büttner, and because the secondary references do not cure this deficiency in Büttner, we reverse both the anticipation rejection and the 35 U.S.C. § 103 rejection.

We observe that appellants discuss a 37 CFR § 1.132 declaration. However, because a prima facie case has not been established, it is not necessary to review such rebuttal evidence.

In view of the above, we reverse each of the rejections.



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